

REMARKS

Reconsideration and allowance of this application are respectfully requested in view of the amendments above and the remarks below.

Claims 1-38

In the Response to the second Office Action, amended claims 1-38 were directed to an invention that is allegedly independent or distinct from the invention originally claimed because the amended claims were presented as method claims whereas the original claims were presented as apparatus claims. In the second Office Action claims 1-38 were withdrawn from consideration as being directed to a non-elected invention.

By this amendment, claims 1-38 are canceled without prejudice, and new claims 39-76 are presented which essentially correspond to original claims 1-38.

Claims 39-50 and 54 directed to a Card

In the first Office Action, original claims 1-12 and 16 (new claims 39-50 and 54) were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Feinberg (U.S. Patent No. 6,082,776). Applicant respectfully traverses this rejection for the following reasons.

Initially, one aspect of applicant's invention is directed to cards to be carried by a person for alerting others that an animal is in need of care. For example, the cards are readily identifiable to others as an animal home alone card and not typical personal medical cards often carried by a person.

In one embodiment, the cards for alerting others that an animal is in need of care includes a substrate and an emergency warning indicia for alerting others that an animal is in need of care on the substrate along with indicia on the substrate for requesting information and designating a printing area for allowing a pet owner to

provide various information such as an address for locating the animal in need of care, a contact person, a description of the animal, and/or veterinarian information. The emergency warning indicia disposed on said substrate may include, for example, a red medical warning symbol and at least one image of an animal, or words or other symbols that alert others that an animal is in need of care such as "ALERT!!! Animals Home Alone."

Thus, a card may be carried by a pet owner, and in the case of an emergency, others may be alerted to the fact that the owner's pets are in need of care. The card provides pet owners with the security of knowing that their pets will not be forgotten in the event of an emergency or accident and where the pet owner is unable to return home.

In addition, independent claims 39 and 54 have been amended to more particularly recite that the cards are "to be carried by a person" and includes an emergency warning indicia "for alerting others that the animal is in need of care." Support for the amendments to the claims is found in the specification and in the drawings.

With regard to the applied prior art, Feinberg discloses a personal medical card for storing personal medical information.

Furthermore, as correctly noted in the first Office Action (page 2, last full sentence), Feinberg does not disclose the specific arrangement and/or contents of the indicia set forth in all of the claims. For example, as correctly noted in the first Office Action on page 3, Feinberg does not disclose indicia for identifying a contact person, as recited in claim 3 (new claim 41); indicia for identifying the address for locating the animal in need of care and the contact person, as recited in claim 4 (new claim 42); veterinarian information, as recited in claim 7 (new claim 45); the specific types of warning indicia, recited in claims 9 and 10 (new claims 47 and 48); and the specific indicia on the sticker, recited in claim 13 (new claim 51).

Feinberg, in addition to not disclosing the specific arrangement and/or contents of the indicia as noted in the first Office Action, also does not mention

animals at all. More importantly, Feinberg fails to disclose, teach or suggest whatsoever alerting others that an animal is in need of care. Moreover, Feinberg fails to address the problem of alerting others that an animal is in need of care which applicant's invention addresses.

Turning now to *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Gulack* was cited in the first Office Action as allegedly supporting the argument that patentability cannot rely upon printed matter where the printed matter is not functionally related to a substrate. In *In re Gulack*, the Court had found a functional relationship between a band and a plurality of digits imprinted on the band, which are developed by an algorithm.

In applicant's invention, the printed matter is functionally related to the substrate, i.e., the printed matter would not achieve its purposes without the substrate (e.g., the substrate is required for inputting the required information), and the substrate without the printed matter would similarly be unable to produce the desired result (e.g., of alerting others that an animal is in need of care). In particular, the printed matter (emergency warning indicia for alerting others that the animal is in need of care and the indicia for requesting information and designating a printing area for identifying at least one of an address for locating the animal in need of care, and a contact person) and substrate are integral to each other by allowing a pet owner to complete and carry the card for alerting others that an animal is in need of care in the event of an emergency.

In addition, the "emergency warning indicia for alerting others that the animal is in need of care" and the "indicia for requesting information and designating a printing area for identifying at least one of a) an address for locating the animal in need of care, and b) a contact person" of applicant's invention interrelates with the substrate more than the simple display of the digits in *In re Gulack* which interrelate with the band.

The court in *In re Gulack* also noted in a footnote that the "printed matter rejection" under §103 is based on case law antedating the 1952 patent act stands on

questionable legal and logical footing. Thus, as further noted by the Court in *In re Gulack*, the claim must be read as a whole with regard to novelty and obviousness.

As noted above, Feinberg fails to disclose, teach or suggest a card for alerting others that an animal is in need of care as recited in new claims 39-50 and 54.

Claims 51-53 and 55-57 directed to a Kit

In the first Office Action, original claims 13-15 and 17-19 (new claims 51-53 and 55-57) were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Feinberg (U.S. Patent No. 6,082,776). Applicant respectfully traverses this rejection for the following reasons.

Another aspect of applicant's invention includes a kit for alerting others that an animal is in need of care which includes a card as noted above, a sticker attachable to a building corresponding to the location of the animal, and wherein the card and the sticker comprise corresponding emergency warning indicia for alerting others that the animal is in need of care.

With regard to Feinberg, Feinberg discloses in column 6, lines 20-29, a personal medical card in which:

When the card 10 is made, the front 10a and back 10b may be printed separately (e.g., using 300 dpi laser printing on the card material comprising card 10 or on a sticker to be affixed to the card material). The back 10b may be a sticker update which can be affixed to a plastic insurance card or a driver's license. Updated stickers may be affixed to prior stickers. Plastic may also be applied over the barcode 19 for durability of card 10.

Thus, Feinberg discloses forming the personal medical card for storing personal medical information by printing on a sticker and then attaching the sticker to the card. More importantly, Feinberg fails to disclose, teach or suggest separate corresponding indicia on both a card and a sticker.

Accordingly, Feinberg fails to disclose, teach or suggest "a card to be carried by a person", "a sticker attachable to a building", and "corresponding emergency warning indicia for alerting others that the animal is in need of care" on the both the card and the sticker as recited in new claims 51-53 and 55-57.

With regard to *In re Gulack*, the printed matter in applicant's kit is even more functionally related to the substrates (i.e., both the card and the sticker having corresponding emergency warning indicia) than just the card alone. Moreover, Feinberg fails to disclose, teach or suggest the combination of a card carried by a person and sticker attachable to a building whatsoever for alerting others that an animal is in need of care.

For all of the reasons above, it is respectfully submitted that new claims 51-53 and 55-57 are patentable over Feinberg.

Claims 58-69 and 73 directed to a Card

In the first Office Action, original claims 20-31 and 35 (new claims 58-69 and 73) were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Feinberg (U.S. Patent No. 6,082,776) in view of Stephens (U.S. Patent No. 5,380,046). Applicant respectfully traverses this rejection for the following reasons.

Another aspect of applicant's invention is directed to a card to be carried by a person for alerting others that an animal is in need of care which includes a first substrate such as a plastic substrate having an emergency warning indicia disposed thereon, a foldable second substrate such as a foldable paper card for receiving various information such as an address for locating the animal, a contact person, a description of the animal, and/or veterinarian information, and the first substrate being attached to the second substrate.

As noted above, Feinberg discloses a personal medical card for storing personal medical information.

Stephens discloses a personal information packet to be carried by a child or other person to provide identification and relevant information to authorities in the

event of an emergency. The packet includes a folded information card bearing personal information on the shielded inwardly folded side of the card sealed within a transparent plastic envelope to secure the card against outward view of the personal information and against unauthorized removal of the card without breaching the sealed integrity of the envelope.

In addition, new independent claims 58 and 73 have been amended to more particularly recite the card "to be carried by a person" and including an emergency warning indicia "for alerting others that the animal is in need of care." Support for the amendments to the claims is found in the specification and in the drawings.

As noted above, in the first Office Action (page 2, last full sentence), Feinberg does not disclose the specific arrangement and/or contents of the indicia set forth in all of the claims. In addition, neither Feinberg nor Stephens mentions animals at all. More importantly, neither Feinberg nor Stephens disclose, teach or suggest any card whatsoever for alerting others that an animal is in need of care. Furthermore, both Feinberg and Stephens fail to address the problem of alerting others that an animal is in need of care which applicant's invention addresses.

More specifically, the combination of Feinberg and Stephens fails to teach or suggest a card for use in alerting others that an animal is in need of care which includes "a first substrate comprising a first side and a second side", "emergency warning indicia for alerting others that the animal is in need of care disposed on said first side", "a second substrate comprising a first side, a second side, and a score line defining said second substrate into foldable and overlapping first and second portions", "said first portion being attached to said second side of said first substrate", and "indicia disposed on said second substrate for requesting information and designating a printing area for identifying at least one of a) an address for locating the animal in need of care, and b) a contact person" as recited in new independent claim 58 (and similarly new independent claim 73).

For the reasons explained above regarding *In re Gulack*, the claimed printed matter is functionally related to the substrates and does distinguish the invention from the prior art in terms of patentability.

Claims 70-72 and 74-76 directed to a Kit

In the first Office Action, original claims 20-31 and 35 (new claims 70-72 and 74-76) were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Feinberg (U.S. Patent No. 6,082,776) in view of Stephens (U.S. Patent No. 5,380,046). Applicant respectfully traverses this rejection for the following reasons.

With regard particularly to the applied prior art, the combination of Feinberg and Stephens fails to disclose, teach or suggest a two-piece card, "a sticker attachable to a building", and providing corresponding "emergency warning indicia for alerting others that the animal is in need of care" on the both the card and the sticker as recited in new claims 70-72 and 74-76.

For the reasons explained above regarding *In re Gulack*, the claimed printed matter is functionally related to the substrates (i.e., both the card and the sticker) and does distinguish the invention from the prior art in terms of patentability.

For the reasons above, it is respectfully submitted that new claims 58-76 are patentable over the combination of Feinberg and Stephens.

CONCLUSION

It is believed that the application is in condition for allowance, and such action is respectfully requested.

If a telephone conference would be of assistance in advancing the prosecution of the subject application, applicant's undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,

A handwritten signature in black ink, reading "David A. Pascarella". The signature is fluid and cursive, with the first name "David" and last name "Pascarella" clearly legible. The signature is positioned above a horizontal line.

David A. Pascarella
Attorney for Applicant
Reg. No. 36,632

Dated: June 22, 2005

HESLIN ROTHENBERG FARLEY & MESITI P.C.
5 Columbia Circle
Albany, New York 12203
Telephone: (518) 452-5600
Facsimile: (518) 452-5579